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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,464

10/13/2005

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PIR-119

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06/26/2008

EXAMINER

REIFSNYDER, DAVID A

ART UNIT

PAPER NUMBER

1797

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/531,464	RUNDT ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	David A. Reifsnnyder	1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7 and 13 is/are rejected.
- 7) ☒ Claim(s) 4 and 8-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Objections*

Claims 4 and 8-12 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claims. See MPEP § 608.01(n). Accordingly, claims 4 and 8-12 not been further treated on the merits. Furthermore, when the applicant corrects the multiple dependency problems with claims 4 and 8-12 he needs to **revise** those claims **carefully** so that the do **not** have any **35 USC 112, 2nd, paragraph issues**. Lastly, even though claims 4 and 8-12 have **not** been treated on the merits, a  **cursory review** of those claims reveals that if the revised claims 4 and 8-12 **depend** from **unamended** claims, they will **most likely be rejected under 35 USC 103 in the next office action.**

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The recitation of “characterized” in claims 1-3, 5-7 and 13 is vague and indefinite as to what is meant by “characterized”. Furthermore, it is unclear as to whether a Jepson type format is intended. (see C.F.R 1.75(e))

Claims 1-3, 5-7 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-3, 5-7 and 13; all of those claims include recitations that are grammatically incorrect and hard to understand. Therefore claims 1-3, 5-7 and 13 should be revised carefully. Examples of problems with claims 1-3, 5-7 and 13 are as follows:

Regarding claim 1; the second recitation of “at least one magnet (13)” is vague and indefinite as to whether the “at least one magnet (13)” is the same as the previously recited “at least one magnet (13)”. Furthermore, it is vague and indefinite as to what is meant by “at least one magnet **or equivalent**”. In addition, the recitation of “such as plate or tube” is vague and indefinite as to whether a plate or tube is being positively claimed. Also, the recitation of “in such manner” is vague and indefinite as to what is meant by **“in such manner”**.

Regarding claim 2; the recitation of “moving at least one magnet (13) and ferromagnetic tube (12)” is vague and indefinite as to whether the “at least one magnet (13)” of claim 2 is the same as the “at least one magnet (13)” of claim 1.

Regarding claim 5; the recitations of “such as plate or tube” is vague and indefinite as to whether a plate or tube is being positively claimed.

Regarding claim 6; it is vague and indefinite as to whether the “at least one permanent magnet (13)” of claim 6 is the same as the “at least one magnet (13)” of claim 5.

Regarding claim 13; the recitation of “inside which the magnet unit can be fitted” is vague and indefinite as to whether the magnet being fitted in the reaction chamber is being positively claimed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by WO 87/05536 who discloses a test tube reactor (1) comprising a chamber containing a magnet body (10) and ferromagnetic particles (3), wherein the magnet body (10) collects the ferromagnetic particles (3) . See Fig. 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3 and 5-7 rejected under 35 U.S.C. 103(a) as being unpatentable over WO 87/05536 in view of Lamb.

WO 87/05536 discloses a method and apparatus for collecting and dispersing ferromagnetic particles (3) in a liquid (2), the apparatus (Fig. 1) comprising a magnetic probe having a cylindrical plastic sleeve (5) with a closed nose shaped thin end (6), the closed nose shaped end (6) having a thinner jacket wall than the rest of the cylindrical plastic sleeve (5) of the magnetic probe; a permanent magnet (10) is movable in the passageway of the cylindrical plastic sleeve; wherein when collecting the ferromagnetic particles (3) the permanent magnet (10) is moved into the closed nose shape end (6); and when dispersing the collected ferromagnetic particles (3), the permanent magnet (10) is moved to a position spaced from the nose shaped end (6). Furthermore, with WO 87/05536 apparatus the area where the ferromagnetic particles are collected and released is only the length of the closed nose shaped end (6).

WO 87/05536 fails to disclose a ferromagnetic body, wherein when collecting the ferromagnetic particles (3), the permanent magnet (10) and the ferromagnetic body are moved in relationship to each other so that the permanent magnet (10) is partly or completely outside the ferromagnetic body, and when discharging the ferromagnetic particles (3), the permanent magnet (10) is partly or completely inside the ferromagnetic body.

Lamb discloses an apparatus (Fig. 1) for collecting and dispersing ferromagnetic particles, the apparatus comprising a magnetic probe comprising a permanent magnet (19) inside an iron tube (13); wherein when collecting the ferromagnetic particles, the permanent magnet (19) and the iron tube (13) are moved in relationship to each other so that the permanent magnet (19) is partly or completely outside the iron tube (13), and when discharging the ferromagnetic particles (3), the permanent magnet (19) is partly or completely inside the iron tube (13). Furthermore, with Lamb's apparatus the area where his ferromagnetic particles are collected and released is almost the entire length of his permanent magnet (19).

It is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention for WO 87/05536 to have used the alternative method of collecting and dispersing ferromagnetic particles as taught by Lamb in order for WO 87/05536 to increase the size of the area where his ferromagnetic particles are collected and released. Furthermore, WO 87/05536 and Lamb disclose similar apparatuses (i.e. magnetic probes).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Reifsnnyder whose telephone number is (571) 272-1145. The examiner can normally be reached on M-F 9:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David A Reifsnnyder/  
Primary Examiner, Art Unit 1797